

REMARKS

Claims 1-22 and 38-39 stand withdrawn as directed to non-elected subject matter. While the Office Action Summary page indicates that only claims 1-22 stand withdrawn, as the previous Restriction Requirement has been made final, Applicants assume claims 38-39 are withdrawn as well.

Claim 23 is amended without prejudice or disclaimer. Claims 24-27, 30-34 and 36 are amended herein. Basis for these amendments may be found throughout the specification and claims as-filed.

Objections to Claims

The Examiner has object to claims 25-29 for improper dependencies. Basee claim 23 is canceled herein without prejudice and claims 25-37 are amended herein to depend upon claim 24. Thus, this objection is obviated.

Rejections under 35 U.S.C. 112, first paragraph

Claims 23 and 25-38 stand rejected as purportedly failing to comply with the written description requirement. The Office argues that the specification fails to disclose that the Applicants are were in possession of mass tag reagents having structures other than those disclosed in claim 24. Claim 38 appears to stand withdrawn, and thus Applicants proceed as if the rejection related to claims 23 and 25-37 only.

Without acquiescing in the rejection and in order to expedite prosecution of this application, base claim 23 has been deleted, and claims 25-37 now depend upon claim 24. Applicants submit that the subject matter of claim 24 is properly supported by the

specification, as evidenced by claim 24's exclusion from this rejection. For example, several compounds falling within the scope of claim 24, as well as their methods of preparation, are described in the specification (see for example compound 4 on page 28, compound 7 on page 30, compound 11 on page 32, compound 16 on page 35).

Claims 25-29 stand rejected, as the specification purportedly fails to describe any mass tag reagents. Claim 29 is deleted herein and thus this rejection is moot.

With regard to claim 25, the Office asserts that the specification fails to describe compounds wherein R^1 and R^2 are selected from the groups as recited in claim 25. However, Applicants note that page 28 of the specification describes a method for preparing compound 4, wherein R^1 and R^2 are both isopropyl groups. Page 35 describes a method of preparing compound 16, wherein R^1 and R^2 are both methyl groups. Accordingly, compounds falling within the scope of claim 25 have been exemplified in the present application. Because the specification provides straightforward methods for preparing compounds wherein R^1 and R^2 are isopropyl and methyl groups it is submitted that the skilled person would also consider that it would be straightforward to prepare compounds wherein R^1 and R^2 are ethyl, propyl, cyclohexyl or benzyl groups. Thus, one of skill in the art would have known that the inventors were in possession of all of the compounds found within the scope of claim 25.

Thus, the rejections under 35 U.S.C. 112, first paragraph should be withdrawn.

Rejections under 35 U.S.C. 112, second paragraph

Claims 25 to 29 stand rejected under 35 U.S.C. 112, second paragraph, as purportedly indefinite. The Office asserts that these claims lack antecedent basis. These dependent

claims are amended to depend upon claims 24 rather than claim 23, and thus this rejection is obviated.

Rejections under 35 U.S.C. 102

Claims 23 to 24, 26, 28 and 30 to 37 stand rejected under 35 U.S.C. 102 as purportedly anticipated by Pappin (U.S. Patent Publication No. 2004/0220412) (“Pappin”). The Office asserts that Pappin discloses mass tag reagents having an identical structure to the third recited formula of claim 24, wherein R³ to R⁶ are hydrogen, X is oxygen, L is an alkylene linker, and the reactive functionality is an N-hydroxysuccinimide ester, and refers in this regard to structure II of Figure 1a.

Without acquiescing in the rejection and in order to expedite prosecution, base claim 24 is amended to delete the third structural formula set forth therein. Thus, this rejection is obviated.

Rejections under 35 U.S.C. 103

Claim 27 stands rejected under 35 U.S.C. 103 as purportedly obviated over Pappin in view of Nitecki (U.S. Patent No. 5,281,698) (“Nitecki”).

Claim 27 specifies that n is 2, such that the label comprises a piperidine group which is a 6 membered nitrogen heterocycle. By contrast, structure II in Figure 1a of Pappin comprises a morpholino group *i.e.*, a 6 membered heterocycle comprising oxygen and nitrogen. Pappin fails to teach or even suggest that the mass label would comprise the piperidine groups of present claim 27. One of skill in the art would note be motivated to change structure II of Figure 1a of Pappin by replacing the morpholino group with a

piperidine group as there is no motivation or reason provided by Pappin to do so. Nitecki in combination with Pappin does not remedy these deficiencies.

Pappin in combination with Nitecki do not recite the present invention. Nitecki is directed to the production of polymer conjugates of proteins. This is an entirely different field from the field of producing compounds for labeling reagents for analysis by mass spectrometry. Accordingly, one of skill in the art would not seek to combine these two references. Further, even if the skilled artisan did combine Nitecki and Pappin, one of skill in the art would not have been motivated to replace the morpholino group of Pappin with the succinimidyl group of Nitecki, because Pappin does not disclose any problem with the use of morpholino groups. In fact, the vast majority of the compounds detailed in Pappin comprise morpholino groups, and thus one of skill in the art would be motivated to use morpholino groups.

However, even if one of skill in the art killed person had replaced the morpholino group of Pappin with the succinimidyl group of Nitecki they still would not arrive at the compounds according to claim 27, because R³ and R⁴ would not be selected from hydrogen and alkyl groups but would rather be ketone groups. Thus, one of skill in the art cannot arrive at present claim 27 by combining Pappin with Nitecki.

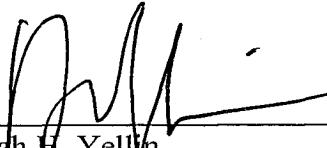
Accordingly, the rejections under 35 U.S.C. 103 should be withdrawn.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 104056.B600303).

Respectfully submitted,

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